

*Amendment in Application 10/790,085
Response AFR of March 27, 2008*

REMARKS

Claims 48-50. Claims 48-50 are not rejected under §§102 or 103. Therefore, if the rejections of their base claims 15-17 under §112, first and second paragraphs, were to be withdrawn, then these claims should become allowable.

Claims 48-50 are canceled and their inclusion into base claims 48-50 is requested. This amendment is proper because it puts the case into condition for allowance, for the reasons below.

Drawing. The amendment to Fig. 21 of January 29 was not accepted (page 2 line 6) and therefore original Fig. 21 stands. There is no drawing objection on page 1.

Specification. The specification is amended back to its original text, as required.

It is argued below that the claims are sufficiently supported without those amendments:

§112, 1st Paragraph. The Examiner repeats the rejection of claims 15 and 17 under 35 U.S.C. §112, first paragraph, for not being supported in the disclosure. There are two separate rejections made under §112, first paragraph, one based on the written description requirement and the other one based on the enablement requirement. These rejections are respectfully traversed.

With respect, the *particular* structure described in the portions of the specification mentioned by the Examiner are not recited in the claims, and the claimed features of a “flange ... to engage a coupler” *is* adequately disclosed, because the flange 151 and the coupler 171 in original Fig. 21 are “engaged” by being in contact, as clearly shown in the drawing; moreover, the specification states that they are “engaged.”

§112, 2nd Paragraph. Another rejection is made of claims 15-17 and 45-50, under 35 U.S.C. §112, second paragraph. The Examiner states that the claims recite tubes for refrigerant and also a pipe for air-tightness testing. The Examiner refers to the “state originally claimed” at page 4, line 5, which is understood to mean the state in which the refrigerant tubes were

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“connected” instead of being only “connectable.” The Examiner explains that this original state is assumed. The Applicants understand that the Examiner is giving no weight to the amendment because it is a change from the originally-claimed “state” and the Examiner believes that the Applicants are not allowed to change the state.

The rejection is respectfully submitted to be both factually wrong and legally erroneous.

(i) The *factual* error is that claim 5 recites a sleeve to which the refrigerant tube is “connectable” (i.e., able to be connected, or potentially connected, but not necessarily connected in actuality). This was changed from “connected” (i.e., actually connected) to avoid claiming that both the refrigerant tube and the test pipe were connected at the same time; now it is the test pipe that is “connected” (last lines of claims 15 and 16). Thus, claim 15 recites only one tube/pipe attached to the container. Although the Examiner appears to recognize this, he also appears to assert that all of the pipes are connected at the same time.

The Examiner first states that not all of the tubes/pipes are connected at the same time (pages 3/4), and then immediately states that they are all connected at the same time (page 4, line 4). However, it appears that the Examiner is making this rejection based on the second interpretation (noting the word “connected” at page 3, fourth line from the bottom), and is asserting that the claims recite an impossible situation and are therefore indefinite. But, with respect, the claims do not recite an impossible situation.

(ii) The Applicants believe that the Examiner is *legally* incorrect because they are unaware of any legal basis for an examiner to refuse to examine a new “state” of an invention. One possible interpretation of the Examiner’s “state” would be that the Examiner actually is referring to an earlier restriction or election of species, but is using the unusual term “state” instead of the usual terms “invention” or “species.” However, this interpretation does not fit the facts. Earlier in this application the Applicants elected Group I, “refrigerant introduction and

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discharge tubes connection means," and did not elect Group II, "piping connections for a two-stage compressor." Claims 22-23 of Group II describe two-stage *refrigerant* valves, rather than the claimed airtightness test pipe. Group III is also irrelevant to our amendment. Thus, there is no basis for the Examiner to refuse to examine the claim based on an earlier restriction.

The Applicants are unaware of any other basis, either.

(iii) With respect, the Examiner's remarks at page 4, lines 6-9, are confusing. They appear to be legally unfounded because "just a capability" provides no recognized legal basis for a rejection.

(3) Claims 15-17 are rejected under 35 U.S.C. §102(b) as being anticipated by Gannaway, US 5,007,807.

The Examiner again asserts (bottom of page 4) that "all of these tube and pipes cannot be connected ... at the same time. Therefore, ... Gannaway [anticipates the claims]." The Applicants respectfully disagree. The question under §102 is whether or not Gannaway discloses all of the claim features, including any connections, as recited; and this is not demonstrated. Moreover, if an applicant claims an impossibility, then the claim should be rejected under §101, not §102.

This rejection is *moot* because these claims are amended to include the subject matter of claims not substantively rejected.

(4) Claims 45-47 are rejected under 35 U.S.C. §103(a) as being obvious over Gannaway in view of Sakae, US 5,261,800, newly applied. This rejection is *moot* because these claims are amended to include the subject matter of claims not substantively rejected.

(5) Claims 34 and 35 are rejected under 35 U.S.C. §103(a) as being obvious over Gannaway in view of Sugiyama, US 4,991,765, newly applied.

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Gannaway arguably discloses an annular projection around the portion of the member 216 that is inserted into the aperture 222 (col. 8, lines 6-9). However, this projection is not "abutted on the flat surface of the ... container" as claim 34 recites. Also, the projection welding disclosed by Sugiyama would result in leaks, because of the radial projections. (Sugiyama discloses an engine push-rod, which does not need to be leak-proof.)

This rejection is *moot* because these claims are amended to include the subject matter of claims not substantively rejected.

In summary, the substantive rejections are rendered moot by the requested amendment and only the formal rejections remain. These rejections are traversed and, with respect, are overcome by the arguments above. Therefore entry and allowance are proper.

Respectfully submitted,

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